1 in 22

AF

PTO/SB/21 (02-04)
Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	09/182,825
Filing Date	10/29/1998
First Named Inventor	WARNER R. T. TEN KATE
Art Unit	2178
Examiner Name	STEPHEN S. HONG
Total Number of Pages in This Submission: 32	Attorney Docket Number: PHN 16695

ENCLOSURES *(Check all that apply)*

- ☐ Fee Transmittal Form
  - ☐ Fee Attached
- ☐ Amendment/Reply
  - ☐ After Final
  - ☐ Affidavits/declaration(s)
- ☐ Extension of Time Request
- ☐ Express Abandonment Request
- ☐ Information Disclosure Statement
- ☐ Certified Copy of Priority Document(s)
- ☐ Response to Missing Parts/ Incomplete Application
  - ☐ Response to Missing Parts under 37 CFR 1.52 or 1.53
- ☐ Drawing(s)
- ☐ Licensing-related Papers
- ☐ Petition
- ☐ Petition to Convert to a Provisional Application
- ☐ Power of Attorney, Revocation Change of Correspondence Address
- ☐ Terminal Disclaimer
- ☐ Request for Refund
- ☐ CD, Number of CD(s) _____
- ☐ After Allowance communication to Technology Center (TC)
- ☐ Appeal Communication to Board of Appeals and Interferences
- ☑ Appeal Communication to TC **(Appeal Notice, Brief, Reply Brief)**
- ☐ Proprietary Information
- ☐ Status Letter
- ☑ Other Enclosure(s) (please Identify below):

Postcard

Remarks

Reply Brief + 2 copies

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Anne E. Barschall, Reg. No. 31.089
Signature	/A E Barschall/
Date	7/19/2004

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Typed or printed name	Anne E. Barschall		
Signature	/A E Barschall/	Date	7/19/2004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application Ser. No.: 09/182,825 Group Art Unit: 2178

Filing Date: 10/29/98 Examiner: STEPHEN S. HONG

Attorney Docket Number PHN 16695 Inventor Name(s): TEN KATE

Title: METHOD FOR CODING A PRESENTATION ...

Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

REPLY BRIEF

GROUPING OF CLAIMS

The Examiner mischaracterizes Appellant's brief as lacking a statement that the claims do not stand or fall together and as lacking separate arguments for individual claims. In fact there is such a statement. Moreover, there are numerous separate arguments relating to claims and groups of claims. Accordingly the claims do *not* stand or fall together.

What structures are claimed?

Appellant would like to begin with the Examiner's last statement "There is [sic] no specific structures claimed." This completely false statement seems to be at the heart of both rejections.

Claim 36, for instance, recites "a sub-presentation program segment comprising a presentation element with a play-out specification ... ; and an interface program segment defining a reference timing..." Thus the claim requires a segment with three elements:

- presentation element, i.e. content to be presented to the user;
- play-out specification; and
- segment defining reference timing.

This is a data structure. It relates to physical organization of data on the storage medium. The data is organized such that it has at least one sub-presentation program segment. The segment includes an element and another segment.

Claims 28 and 37 are similar in this respect.

The Examiner's complete failure to recognize these claim recitations is utterly baffling.

"Program"

Applicant has pointed out that the adjective "program" as used in phrases "program portion" and "program segment" relates to the type of "program" that would appear on a television. Applicant would like to point out further that the verb "to program" -- or "programmed" in its past tense as used in the claims -- relates to the type of programming to be done in a data processing device.

Applicant regrets the necessity of combining these two different meanings of the word "program" in the same claims, due to the limitations of the English language. However, Applicant believes that the claims are nevertheless clear to one of ordinary skill in the art.

Independence of definition of reference timing

Independent claims 28, 35, 36, and 37 all recite that the reference timing is defined independent of the presentation element. However, the reference timing is still recited as being in the segment that also has the presentation element and the play-out specification. This is a physical issue of organization of the data.

The Examiner has never really addressed this issue. The Examiner points to a user interface with icons whose size represents timing information. If the Examiner is implying that the icon is a presentation element with respect to the graphical user interface, then the timing information is not separate from the presentation element. On the other hand, if the Examiner is implying that the presentation element is not actually in the icon, then the presentation element is not within the segment as claimed.

The Examiner even apparently admits in his answer that the presentation element of the

program to be presented is stored somewhere else in the computer from the icon, and therefore not in the segment with the other information as claimed.

Gudmondson & Claim 44

Gudmondson is cited against the recitations of claim 44. Gudmondson relates to the field of object-oriented programming. Gudmondson's containers are "objects." Applicant would like to say a bit more about object-oriented programming, as explained in the FOLDOC Internet document submitted earlier in prosecution. This definition explains that objects are data structures encapsulated with routines. For instance, in Gudmondson, at col. 8, line 43, objects receive messages. Accordingly, objects are not merely data structures. They typically contain data structures, though the Examiner has not demonstrated what data structures these objects actually contain.

Objects *are* self-contained. In other words, one object cannot access the data structures of another object. Such an access would be a violation of object-oriented programming techniques. Even if one object is encapsulated within another object, the data structures within the encapsulated object should not be put together with the data structures of the encapsulating object. They need to remain separate so that the objects remain modular.

Claim 44 recites a sub-sub presentation data structure within a sub-presentation data structure, namely a hierarchy with in a data structure. This should not be possible in Gudmondson, even if one reads the reference to say what the Examiner thinks it does. The data structures in objects farther down a hierarchy of objects should not be accessible to or combined with data structures in objects farther up in a hierarchy. Such access or combination would

violate the self-contained nature of objects.

Accordingly, the Examiner has failed to make a *prima facie* case of obviousness with respect to claim 44.

NEW POINTS OF ARGUMENT WITH RESPECT TO NON-STATUTORY SUBJECT MATTER (THE EXAMINER'S ANSWER AT PAGES 9-10)

The new points of argument in the Examiner's Answer cut right to the heart of the Examiner's misunderstanding of the law. He states in the middle of page 10:

> "Here MPEP [sic] gives a good example, noting that 'non-statutory music ... does not become statutory by merely recording it on a compact disk.' Similarly, the Appellant's claimed 'presentation element with a play-out specification' is no different from a musical note with its playout specification (i.e. duration, how high the note is, etc.)"

The MPEP says that "nonstatutory music ... does not become statutory by merely recording it on a compact disk." [emphasis added] In other words, it has generally been held that the music itself is not patentable. A particular piece of music does not become patentable by being recorded.

By contrast, a type of playout specification of music certainly could be patentable per In re Lowry, if it were new and non-obvious and if it specified:

- physical interrelationships between information in memory; and/or
- how an application program might manage information; and/or
- functional characteristics of memory.

even if it were only for recording music. A new and non-obvious type of play-out specification is ***not*** "nonfunctional." It *is functional*. It has the function of specifying play-out.

The Examiner does not seem to grasp that the technique for specifying play-out is independent of data to be played out. The same piece of music might be specified according to several standards. The same standard might specify any number of different pieces of music. The music is not the same as the standard according to which it is recorded. Thus an upgraded version of the .wav standard would be patentable, if new and non-obvious; while a particular song, such as "Living La Vida Loca," would most likely not be.

Here, the claims do not recite particular, text, audio, or video content of program portions. They do not say "Star Trek Episode #10," for instance. The claims specify the functional and physical interrelationships of information on the disk, not the content itself.

The Examiner even cites the language

> "the ... segment comprises a group of [presentation] elements which are programmed to be presented simultaneously with respect to each other."

from claim 30. Inexplicably he thinks this is like a recitation of a recording of a particular piece of music or video. In fact, a segment comprising a group of presentation elements defines structure on the medium. "Programmed to presented simultaneously" defines the function of an application program.

By contrast, if the claim said "a video recording of the second Harry Potter movie in which Harry Potter, Ron Weasley, and Hermione Granger all appear at the Hogwarts School together in the same picture" that would be content. In such a picture, Harry, Ron & Hermione are not elements of a segment on a medium as recited. They are not programmed to appear together. They are all part of the same picture to start with. It is this type of specific content, i.e. a specific picture, that the section of the MPEP strives to avoid becoming the subject of a patent,

but this is not what Appellant has claimed.

The Examiner says that musical notes can be elements that can be programmed to be presented simultaneously. If so, then the Examiner should phrase this as an art rejection and present prior art that says so. Otherwise, so far as Appellant knows, the notes are all recorded together as a conglomerate of frequencies, not as elements that are presented together by being programmed.

Moreover, the material in the claim would not readily lend itself to copyright protection, unlike the unpatentable material described in MPEP 2106. Copyright protection relates to a form of expression, such as the particular composition of a photograph or the words in text. Copyright protection does not protect function, such as that recited in the claims.

NEW POINTS OF ARGUMENT WITH RESPECT TO THE ART REJECTIONS OVER MOORBY (EXAMINER'S ANSWER AT PAGES 11-12)

The Examiner's new points of argument with respect to the reference accentuate his confusion between the structure of data in memory and content to be presented on the screen. These new points of argument also highlight the Examiner's misunderstanding of what is claimed.

The Examiner says "Moorby graphically shows how the presentation elements are synchronized," but Applicant does not claim showing how presentation elements are synchronized.

As explained above, Claim 36, for instance, recites a sub-presentation program segment comprising a presentation element with a play-out specification ... ; and an interface program

segment defining a reference timing..." Thus the claim requires a segment with three elements:

- presentation element, i.e. content to be presented to the user;
- play-out specification; and
- segment defining reference timing.

The Examiner says "Appellant somehow appears to continue making the argument as if the graphical displays must be able to store the data on the graphic itself." **YES** !!!, The claims *require* all three categories of items to be in a segment. The graphic icon the Examiner is referring to does not store the elements as claimed.

The Examiner admits "Applicant should recognize that whatever displayed [sic] on the screen is not the whole data." This is exactly right, and is exactly Applicant's point. The reference is a graphical user interface. This is visual content, as displayed on the screen. The structures in memory that relate to this interface are unknown and need not be stored as claimed by Applicant at all. There are many other ways that the data could be organized. For instance, there could well be four separate files with, respectively:

1. timing information relating to all presentation elements;
2. image data for creating all the possible visual displays of the graphical user interface;
3. several presentation elements to be selected using the icons on the graphical user interface, e.g. the actual audio/video material; and
4. additional play-out specification material.

These four files could even be on distinct media. For instance, some might be on a DVD and some might be on a hard drive. Software could integrate the functioning of such separate files to create the graphical user interface shown in Moorby and to effect play-out in response to

selection of icons. Such a structure would not anticipate the invention or render it obvious at all.

The Examiner says "Applicant is misconstruing the Moorby reference by saying that the 'icons' are the only things that are stored in the computer of Moorby." Applicant has not said any such thing. Certainly something must be stored in Moorby's computer. The problem is that the Examiner has not demonstrated what that is – and *a fortiori* has not demonstrated that what is stored in the computer is the segment and element data structures claimed by Applicant.

The Examiner says "since Moorby's storage contains both the playout data and the playout specification indicating how the presentation element is to be played,' the claim limitations are clearly met." But this is not what the claims recite, that such data could be anywhere in storage. There has to be a segment with the elements as claimed. Just having the data anywhere in any storage fails to teach or suggest the specific data structures set forth in the claim.

The Examiner completely mischaracterizes the claims in saying "There is [sic] no specific physical structures claimed." Applicant has pointed out these structures in great detail with respect to numerous claims.

Applicant respectfully submits that he has answered each issue raised by the Examiner and that the application is accordingly in condition for allowance. Such allowance is therefore respectfully requested.

Respectfully submitted,

By e/Barschall

Anne E. Barschall
Reg. No. 31,089
(914) 332-1019
fax 914-332-7719
July 19, 2004

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited this date with the United States Postal Service as first class mail in an envelope addressed to

Mail Stop Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

On 7/19/2004 (Mailing Date)
By e/Barschall (Signature)